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Ray R. Regan, Registration No. 36,899

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

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|----------------------------|--|
| In re Application of: | John E. Liebendorfer |
| Filing Date: | July 20, 2001 |
| Sole Inventor: | John E. Liebendorfer |
| For: | A System for Removably and Adjustably Mounting a Device on a Surface |
| Application Number: | 09/910,655 |
| Attorney Docket Number: | 2164.004 |
| Express Mail Label Number: | ED666641876US |
| Group Art Unit: | 3632 |
| Examiner: | Anita M. King |

APPELLANT'S REPLY BRIEF

To: Mail Stop APPEAL BRIEFS-PATENTS
Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

As provided in 37 C.F.R. Subpart B ("Ex Parte Appeals") §§41.30 *et seq.* (collectively, "Appeal Rules"), Appellant submits to the Board of Patent Appeals and Interferences ("Board") this Reply Brief, in triplicate.

Appellant filed a Notice of Appeal and Appellant's Appeal Brief on April 14, 2005. The Examiner mailed an Answer Brief on July 5, 2005. The Appeal Rules, specifically 37 C.F.R. §41.41, provide Appellant two (2) months to file this Reply Brief. Accordingly, this Reply Brief is timely filed.

Applicant requests withdrawal of the rejections made by the Examiner, reversal of the Examiner's rejections, and requests allowance of the application.

No fees are required by 37 C.F.R. §1.17(c) for filing this paper. The Commissioner is, however, authorized to charge any fees occasioned by this paper to Account Number 501565 for the Law Office of Ray R. Regan, P. A., and to deposit any overpayments to Account Number 501565.

(1) Addressing Comments of Examiner in Answer Brief

The Examiner twice included comments about the listing of claims included by Appellant in the Appeal Brief. In paragraph (3) of the Answer Brief, page 2, the Examiner stated that the statement of the status of claims contained in Appellant's Appeal Brief is incorrect. No specifics, however, were included. The Examiner repeated the comment in paragraph (7) of the Examiner's Answer Brief, page 3, stating that "substantial errors" appear in the listing of claims included in Appellant's Appeal Brief, and that claims 1, 3, 4, 5-16, 17-23, 31 and 34-37 therefore were "correctly written in the Appendix to the Examiner's Answer."

Appellant, therefore, conducted a detailed, claim-by-claim review of both Appellant's and Examiner's statement of the status of claims and the claims listing themselves, and compared them with the new rules governing *ex parte* appeals to the Board as provided in 37 CFR §§41.30 *et seq.* (collectively, "Appeal Rules").

As a result, Appellant submits that:

A. There appears to be no substantive difference between the statements of the status of claims presented by Appellant and that of the Examiner. A semantic difference may exist about the meaning of certain words in the Appeal Rules. 37 CFR §41.37 (c)(1)(iii) provides that

an appellant should include a statement of the status of the claims. The statement of the status of claims is supposed to include “all claims in the proceeding.” (Emphasis added.) The rule goes on to state, “e.g. [the term ‘e.g.’ meaning ‘for example’], claims that have been “rejected, allowed, or confirmed, withdrawn, objected to, canceled.” Appellant submits that Appellant’s listing of claims is complies with those requirements.

B. Regarding the listing of claims submitted by Appellant and the Examiner in their respective appendices, there appears to be a difference in interpretation of the meaning of the phrase “involved in the appeal.” 37 CFR §41.37 (c)(1)(viii) provides that Appellant is required to include a listing of claims “involved in the appeal.” As previously indicated, the Appeal Rules require Appellant to include statement of the status is of “all claims in the proceeding” which include “for example,” according to the Code section, all claims that have been rejected, allowed, or confirmed, withdrawn, and so on.

1. Following a word-by-word and line-by-line comparison of the different listings of claims submitted by Appellant and the Examiner, Appellant concluded that it is the Examiner’s listing of claims that fails to include claims that were canceled, withdrawn, allowed, or objected to. Given the requirements of 37 CFR §41.37 (c)(1)(iii), however, Appellant submits that the differences hardly rise to the status of “substantial errors.”

2. Rather, the differences between the two claims listings may be attributable to differing interpretations of the meaning of the phrase “involved in the appeal.” Appellant believes that, in view of 37 CFR §41.37 (c)(1)(iii), and its requirement to provide a “statement of the status of all the claims in the proceeding (emphasis added),” that claims that have been objected to are “involved” in the appeal, whether directly or indirectly. Merriam-Webster’s dictionary (electronic version) defines the word “involved” as meaning “to include; to require as a necessary accompaniment; to have an effect on.” Appellant submits that dependent claims depending from rejected claims would certainly be “included” within the meaning of that definition, and certainly would “have an effect on” the appeal.

3. Accordingly, Appellant submits that: (a) the listing of claims in Appellant's Brief correctly complies with the Appeal Rules, including 37 CFR §41.37 (c)(1)(iii); (b) the listing of claims in Appellant's Brief also correctly complies with 37 CFR §41.37 (c)(1)(viii) because the listing of claims includes those "involved in the appeal;" and that the listing of claims in Appellant's Brief includes nothing that could be construed as a "substantial error."

C. Thus, for example, the Examiner states on page 3 of the Answer Brief, paragraph (9) that claims 1, 3, 4, 6-10, 17-19, and 21 stand rejected as anticipated by the Byers Patent. That is precisely what Appellant stated in Appellant's Appeal Brief. See Appellant's Appeal Brief, page 7, paragraph (7) A. 1. The fact that other claims are included in the Claims Appendix of Appellant is consistent with the instructions contained in the Appeal Rules.

(2) Addressing Arguments of Examiner in Answer Brief

A. Rejections of Claims under the Byers Patent.

1. The General Rejection. The Examiner states on page 3 of the Answer Brief, paragraph (9) that claims 1, 3, 4, 6-10, 17-19, and 21 stand rejected as anticipated by the Byers Patent.

The Examiner's arguments are fully met by Appellant in Appellant's Appeal Brief, pages 7-13.

a. New Argument of Examiner. A new argument advanced by the Examiner, evidently in an effort to satisfy the all-elements rule for a §102 rejection, is that the footing grid of Appellant's claims are found in the Byers patent as "the plurality of elements 80 in Fig. 3 which are a mounting member disposed under a plurality of shingles 98." See Answer Brief, page 3, paragraph (9). That argument is without merit. The roof strut shown by element 80 in the Byers Patent is totally unrelated to Appellant's footing grid.

Appellant's footing grid is described in the Application:

As used in this document the term "footing grid" includes a network of keepers often, but not exclusively, L-shaped and formed with at least one hole in each extension of the "L." The keepers are connectable to a surface and are formed and shaped to permit attachment of other hardware components such as rails and frames on which modules may be attached. (See Application, page 12, lines 10-16, emphasis added.)

Also, none of the solutions provided an apparatus, and method for installing the apparatus, that would be universal. The term "universal" refers to an apparatus and method for mounting modules on a wide variety of surfaces that not only accommodate all known shapes, configurations, and numbers of modules, but also permit installation top down as well as bottom up. In the industry associated with installation of photovoltaic modules, the term "top down" refers to mounting photovoltaic modules on structures such as frames and rails that are attached first to the footing and on the surface on which the module is to be mounted before the module is attached to the frames or rails. For example, in the case of a module to be mounted on a building, one or more rails first would be attached to a footing grid that earlier has been attached to the surface, in this instance the roof; thereafter, one or more modules would be attached to the rails. Hardware that secures the module to the rails is attached from the top, or front, of the module. (See Application, pages 3, lines 26-29 and carry-over to page 4, lines 1-8, emphasis added.)

In addition, the present invention also allows assembly of photovoltaic modules of any size or shape on a variety of surfaces, while insuring that the footing grid remains securely attached to the surface. (See Application, page 5, lines 21-25, emphasis added.)

As shown in Figure 1 of the Application, the footing grid is on top of the roof, or on top of the shingles of a roof. Figure 1 shows the footers 36 that comprise a footing grid as being on top of the roof. The footing grid is not underneath the shingles as shown in Figure 3 of the Byers Patent.

Thus it should be clear that the keepers comprising the footing grid are attached to the surface of a roof, or to the outer surface of shingles of a roof. The footing grid is not a structural element met by the roof strut shown in Figure 3 of the Byers Patent.

2. Examiner Incorrectly Invokes the Casey and Otto Cases. In another effort, evidently, to bolster an argument that the Byers Patent satisfies the all-elements rule the Examiner incorrectly cites the decisions in two CCPA decisions. On page 6 of the Answer Brief the Examiner cites *In re Casey*, 370 F.2d 576, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 312 F.2d 937, 939, 136 USPQ 458 (CCPA 1963). The Examiner cites the Casey and Otto cases as supporting the Examiner's argument that "[i]f the prior art structure is capable of performing the intended use, then it meets the claim." The Examiner's arguments involving those cases are incorrect for at least the following reasons:

a. The Examiner seeks to apply the decisions of the Casey and Otto cases without the predicate. Even were the Examiner's abbreviated summary of the Casey and Otto cases correct, the predicate is: "if the prior art structure is capable of performing the intended use." There is no showing that the multiple light system of the Byers Patent is capable of performing the intended use of Applicant's invention. The intended use of Applicant's invention is clearly shown throughout the Application. As stated in paragraph (5) of Appellant's Appeal Brief, "the claimed subject matter relates to an apparatus for mounting a device, including photovoltaic devices such as photovoltaic modules, on a surface...that may include a roof or pole...." See Appellant's Appeal Brief, page 5. In the Answer Brief the Examiner agreed with Applicant's summary of the invention. See Answer Brief, page 2. There is no evidence that the lighting system of the Byers Patent is capable of performing use as a photovoltaic module mounting device.

b. The Casey and Otto cases involved questions arising under 35 U.S.C. §103 (obviousness), not 35 U.S.C. §102 (anticipation). The Examiner, however, has advanced the Casey and Otto cases to support an anticipation argument under 35 U.S.C. §102(b)

and §102(e): see Final Office Action, Page 2. The Final Office Action includes no rejection under 35 U.S.C. §103.

c. The Casey and Otto cases, however, are directed exclusively to rejections under 35 U.S.C. §103. Thus, when the Examiner dismisses the argument of Applicant that Byers teaches improvements in components for mounting decorative light strings to various mounting sites, the Examiner does so for the wrong reasons and wrong reasoning. Citation of the Casey and Otto cases disregards the MPEP requirement that “words in patent claims are given their ordinary meaning in the usage of the field of the invention...” See MPEP §2111.01.II (emphasis added). The Casey case, which dealt with a machine for dispensing adhesive tape, the court expressly noted that claim 1 was rejected over the prior art under 35 U.S.C. §103. See *Casey*, 370 F.2d 576 at 578. The Otto case, decided before the Otto case, also clearly was based on the question of obviousness because the examiner rejected claims over one patent in view of two other patents, which can only be done in an obviousness rejection.

d. Accordingly, the arguments of the Examiner on this point are without merit.

B. Rejection of Claims under the Schauss Patent. The Examiner states on pages 4-5 of the Answer Brief, that claims 31, 32, 34, and 37 stand rejected as anticipated by the Schauss Patent under 35 U.S.C. §102(e).

The Examiner’s arguments are fully met by Appellant in Appellant’s Appeal Brief, pages 14-15.

1. Examiner Incorrectly Invokes the Casey and Otto Cases. As in the case of the Byers Patent noted above, the Examiner again incorrectly cites the Casey and Otto cases. See Answer Brief, page 7. The Examiner cites the Casey and Otto cases as supporting the Examiner’s argument that “[i]f the prior art structure is capable of performing the intended use, then it meets the claim.”

Again, the Examiner's arguments involving those cases are incorrect for at least the following reasons:

a. As before, the Examiner seeks to apply the decisions of the Casey and Otto cases without the predicate. Even were the Examiner's abbreviated summary of the Casey and Otto cases correct, the predicate is: "if the prior art structure is capable of performing the intended use." There is no showing that the attachment structure for attaching a robot arm and for securing tools of the Schauss Patent is capable of performing the intended use of Applicant's invention. The intended use of Applicant's invention is clearly shown throughout the Application. As stated in paragraph (5) of Appellant's Appeal Brief, "the claimed subject matter relates to an apparatus for mounting a device, including photovoltaic devices such as photovoltaic modules, on a surface...that may include a roof or pole...." See Appellant's Appeal Brief, page 5. In the Answer Brief the Examiner agreed with Applicant's summary of the invention. See Answer Brief, page 2. There is no evidence that the attachment structure for attaching a robot arm and for securing tools of the Schauss Patent is capable of performing use as a photovoltaic module mounting device.

b. The Casey and Otto cases involved questions arising under 35 U.S.C. §103 (obviousness), not 35 U.S.C. §102 (anticipation). However, the Examiner has advanced the application of the Casey and Otto cases to support an anticipation argument under 35 U.S.C. §102(b) and §102(e): see Final Office Action, Page 2. The Final Office Action includes no rejection under 35 U.S.C. §103.

c. The Casey and Otto cases, however, are directed exclusively to rejections under 35 U.S.C. §103. Thus, when the Examiner dismisses the argument of Applicant that Byers teaches improvements in components for mounting decorative light strings to various mounting sites, the Examiner does so for the wrong reasons and wrong reasoning. Citation of the Casey and Otto cases disregards the statement in the MPEP that "words in patent claims are given their ordinary meaning in the usage of the field of the invention...." See MPEP §2111.01.II. The Casey case, which dealt with a machine for dispensing adhesive tape, the court

noted that claim 1 was rejected over the prior art under 35 U.S.C. §103. See Casey, 370 F.2d 576 at 578. The Otto case, decided before the Otto case, also clearly was based on the question of obviousness because the examiner rejected claims over one patent in view of two other patents, which can only be done in an obviousness rejection.

d. Accordingly, the arguments of the Examiner on this point are without merit.

(3) Addressing the Examiner's Responses to Arguments

In the Answer Brief of the Examiner, pages 5-8, the Examiner advances responses to the arguments of Appellant in Appellant's Appeal Brief. Appellant respectfully submits that the responses are without merit.

A. On page 5 of the Answer Brief the Examiner asserts that the limitation of the footing grid is met by reference character 80 in the Byers Patent.

The assertion is the same assertion fully met by Appellant in this Reply Brief under subparagraph A.1.a., pages 4-5.

B. On pages 5-6 of the Answer Brief the Examiner asserts that in the "broadest interpretation of the term 'clamp'" the Byers Patent "teaches clamps (64, 74, or 102)."

As stated by Appellant on pages 9-10 of Appellant's Appeal Brief, what matters is not the broadest interpretation, but the broadest interpretation reasonably consistent with the specification.

MPEP §2111.01 requires that "...pending claims must be given their broadest reasonable interpretation consistent with the specification." MPEP §2111.01 also provides, as the examiner correctly pointed out on page 5 of the Final Office Action: "This means that the words of the claim must be given their plain meaning unless applicant has provided a clear definition in the specification."

Appellant clearly defined the term “clamp” in the Application as follows:

The unique dual track rail of the present invention, in combination with the novel clamps of the present invention, also permit ready slidable adjusting and readjusting of the location on a rail on which the module may be positioned. (See Application, page 5, lines 23-25, emphasis added.)

To add universality of application to the present invention, the system for removably and adjustably mounting a device on a surface also includes at least two different constructions of clamps for top down mounting. One configuration of the clamps is a duct with at least two opposing shoulders substantially perpendicular to one another, and is used primarily for mounting adjacent edges of different modules to a rail. Another configuration of the clamp is a leg having a descending member and an ascending member extending in opposite directions. A lip, or fin, is provided on the two opposing shoulders, as well as on the ascending member, to provide torsional clamping power on the edges of modules. The leg-shaped clamp is an end clamp, used primarily to mount an edge of a module to a rail. The clamps maybe repositioned along the rail formed with at least two tracks, making the system easily and quickly reconfigurable. (See Application, page 6, lines 6-15, emphasis added.)

The clamps are shown in Figures 8-11 of the Application.

Neither the slide channel 64 of the Byers Patent (see column 4, line 29), nor the slide guide 74 (see column 4, line 44), nor the gutter clip 102 (see column 5, line 10) provide either the structure or the cooperation of structure of the clamps described and claimed by Appellant.

C. On page 6 of the Answer Brief the Examiner asserts that Appellant does not claim a rail that is solid rather than hollow, and therefore (implicitly) the requirement of the Examiner for allowability, namely including the limitation of claim 5 in claim 1, is appropriate.

Appellant respectfully submits that the assertion of the Examiner is without merit.

While that argument is fully met and overcome by Appellant in Appellant’s Appeal Brief, pages 8-9, Applicant also submits the following comments.

1. Background. Claim 5 depends from independent claim 1. Dependent claim 5, among other features, provides for a "...a rail...formed with a body having a proximal end, a distal end, and a hollow chamber there between." See Claim 5, Listing of Claims, attached.

The Examiner apparently requires as a condition of allowance of claim 1 that independent claim 1 include the limitation of a hollow chamber. Applicant respectfully submits that the limitation is neither suggested by references cited by the Examiner, nor required by any construction of the Application under examination.

As provided in the specification of the Application, hollow chamber 26 is formed between proximal end 22 and distal end 24 of body 20. Hollow chamber 26 contributes to the lightweight yet structural rigidity of one embodiment of the rail, and therefore to its ease of handling during installation of the claimed system. See Application, page 8, lines 24-27. Hollow chamber 116 is shown perhaps best by reference to Figure 3 reproduced below.

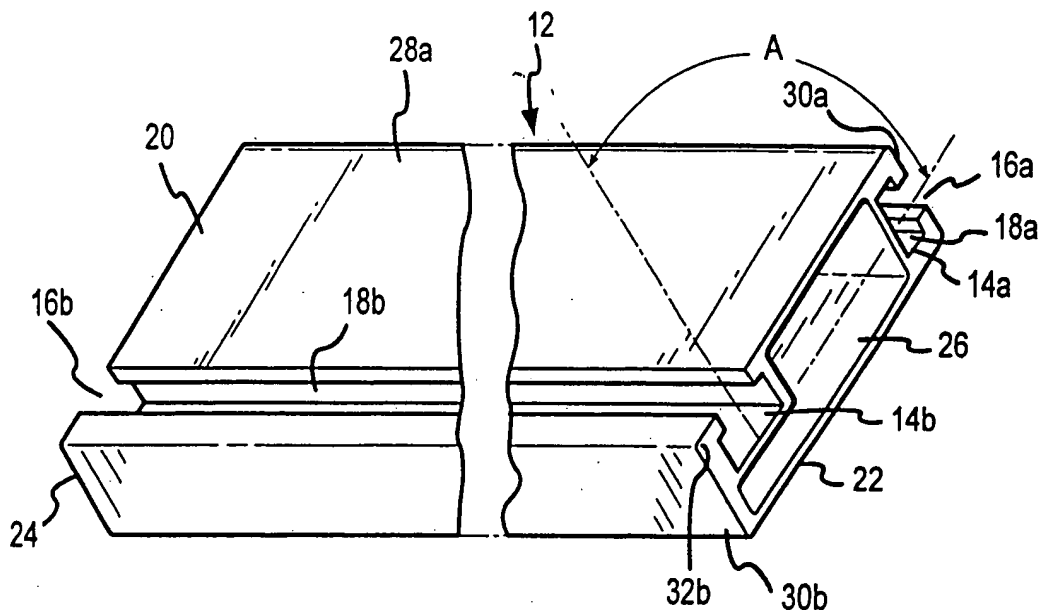


FIG.3

Independent claim 1 of claim set 1-9 does not claim a hollow chamber. Appellant respectfully asserts, therefore, that the Examiner's indication of allowance subject to the requirement of a claim amendment to include the hollow chamber is contrary both to MPEP §2111.01 and to several decisions of the Court of Appeals, Federal Circuit, including *Liebel-Flarsheim Company vs. Medrad, Inc.*, 358 F.3d 898, 69 USPQ2d 1801 (Fed. Cir. 2004).

2. Analysis. MPEP §2111.01 briefly notes that the Liebel-Flarsheim case, among other cases, has “rejected the contention that if a patent describes only a single embodiment, the claims...must be construed as being limited to that embodiment.” See MPEP §2111.01.I.

The brief single-sentence MPEP summary of the Liebel-Flarsheim case does not adequately present the guidance of the CAFC regarding this issue. Appellant, therefore, includes the following comments.

The apparatus claimed in the Liebel-Flarsheim case was a mechanical apparatus. The apparatus was a powered fluid injector for injecting fluids into patients during medical procedures. The patents in issue did not contain a description of an injector without a “pressure jacket,” but discussed only a fluid injector in combination with a pressure jacket. The trial court, therefore, construed all claims to require a pressure jacket, although, as in this case, certain independent claims did not claim a pressure jacket. Restated, the district court held that because the specification discussed a pressure jacket, the claims could not include the absence of a pressure jacket “even though the asserted claims might be considered broad enough to disclose a jacketless injector when read without reference to the specification.” *Liebel-Flarsheim*, 358 F.3d 898, at pages 900, 902.

The Examiner in this case appears to advance a similar argument. The Examiner's condition for allowance of independent claim 1 implies that because a hollow chamber is described in the specification of the Application, a claim directed to a solid rail, or the absence of a hollow chamber, is impermissible. Applicant respectfully submits that such an argument is unwarranted.

In the *Liebel-Flarsheim* case the Court rejected that argument. Indeed, the CAFC reversed the trial court. The Court rejected Medrad's argument that because all embodiments described in the specification showed pressure jackets, the claims must be construed as limited to devices using only pressure jackets. The Court noted "there are several answers to Medrad's argument" (see *Liebel-Flarsheim*, 358 F.3d 898, at page 903):

a. "The first is that this court has expressly rejected the contention that if a patent describes only a single embodiment, the claims of the patent must be construed as being limited to that embodiment," citing several earlier decisions. *Liebel-Flarsheim*, 358 F.3d 898, at page 903.

b. "Even when the specification describes only a single embodiment, the claims of the patent will not be read restrictively unless the patentee has demonstrated clear intention to limit the claim scope using 'words or expressions of manifest exclusion or restriction.'" *Liebel-Flarsheim*, 358 F.3d 898, at page 903, citing *Teleflex, Inc. vs. Ficosa N. Am. Corp.*, 299 F.3d 1313, 1327 (Fed. Cir. 2002) (emphasis added). Applicant submits that nothing in the Application under examination shows words or expressions of manifest exclusion or restriction of the mounting system to including a hollow chamber.

c. If the specification discusses only a single embodiment, it is improper to limit the claims unless there is an express disclaimer or surrender. *Liebel-Flarsheim*, 358 F.3d 898, at page 903 (emphasis added). Applicant submits that nothing in the Application under examination shows an express disclaimer or surrender of a solid rail.

d. Furthermore, the doctrine of claim differentiation "provides significant added support" for Liebel's position. *Liebel-Flarsheim*, 358 F.3d 898, at page 906:

The juxtaposition of independent claims lacking any reference to a pressure jacket with dependent claims that add a pressure jacket limitation provides strong support for [the] argument that the independent claims were not intended to require the presence of a pressure jacket. As this court has frequently stated, the presence of

a dependent claim that adds a particular limitation raises a presumption that the limitation in question is not found in the independent claim. (Emphasis added.)

3. Conclusion. Applicant respectfully submits, therefore, that independent claim 1 of claim set 1-9, should be allowed.

D. On pages 6 and 7 of the Answer Brief the Examiner twice asserts in response to Appellants arguments in Appellant's Appeal Brief that:

[A] recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

Appellant respectfully submits that in both instances the attempted application of the Examiner's assertion is without merit in this case for at least the following reasons:

1. Appellant has identified both in Appellant's Appeal Brief as well as in this Reply Brief the numerous structural differences between the claimed invention and the prior art.

2. More significantly, the prior art structures of the Byers Patent and the Schauss Patent are inherently incapable of performing the intended use of Appellant's invention.

3. The assertion of the Examiner purports to be based on *In re Casey* and *In re Otto*, but both of those cases are cited in the MPEP in connection with obviousness rejections (see MPEP §2115), with the following express limitation: "Note that this line of cases is limited to claims directed to machinery which works upon an article or material in its intended use."

4. The Examiner has shown no possible way in which the multiple light system of the Byers Patent, or the supporting structure of the Schauss Patent, either satisfies the

all-elements rule for anticipation, or could be used for mounting photovoltaic panels on a surface such as a roof.

E. On pages 7-8 of the Answer Brief the Examiner asserts that both the Byers Patent and the Schauss Patent teach the slot of Appellant's apparatus.

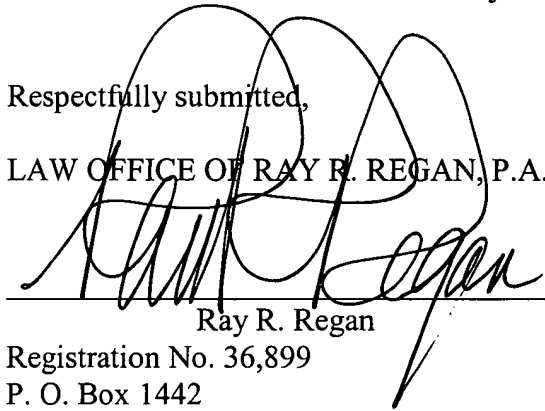
The Examiner's arguments are fully met by Appellant in Appellant's Appeal Brief, at pages 6, 10 and 15.

(4) Conclusion

In view of the foregoing, Appellant respectfully requests that the Board of Patent Appeals and Interferences reverse the Final Rejection of claims and hold Appellant's claims allowable.

Respectfully submitted,

LAW OFFICE OF RAY R. REGAN, P.A.

A large, stylized handwritten signature in black ink, appearing to read 'Ray R. Regan', is written over the text of the signature block.

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